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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,656	03/03/2005	Luigi Resconi	FE 6048 (US)	5823
34872	7590	12/21/2007		
Basell USA Inc. Delaware Corporate Center II 2 Righter Parkway, Suite #300 Wilmington, DE 19803			EXAMINER LEE, RIP A	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 12/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,656	Applicant(s) RESCONI ET AL.	
	Examiner Rip A. Lee	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5 and 8-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 1, 3 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10-19-2007</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

This office action follows a request for continued examination (RCE) under 37 § C.F.R. 1.114, filed on October 18, 2007. Claims 1-3, 5, and 8-11 are pending. This office action is based on the latest version of claims filed on April 9, 2007.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-3, 5, and 8-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-21 and 23 of copending Application No. 10/571,404. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process of preparing a polymer of ethylene and C₄₊ alpha olefin in the presence of substantially the same catalyst. Note especially in claim 18 of the copending application where R¹ ≠ H and claim 23 where R⁷ is C(R¹⁴)₃.

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3. Claims 1-3, 5, and 8-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21-27, 29, 32, 33, 37, 38, and 40 of copending Application No. 10/571,389. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process of preparing a polymer of ethylene and C₄₊ alpha olefin in the presence of substantially the same catalyst. Note especially in claim 21 of the copending application where $R^1 \neq H$, claim 25 where R^4 , R^5 , or $R^6 \neq H$, and the combination of claims 25 and 26 where $R^5 \neq H$ and R^3 , R^4 , R^6 , R^7 are hydrogen.

4. Claims 1-3, 5, and 8-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 23-27, 29, 30, 31, 33, 36, 37, 41, 42, and 44 of copending Application No. 10/571,403. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process of preparing a polymer of ethylene and C₄₊ alpha olefin in the presence of substantially the same catalyst. Note especially in claim 23 of the copending application where $R^1 \neq H$ and claim 30 where R^5 is $C(R^{12})_3$.

5. Claims 1-3, 5, and 8-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-22, 24-28, 30, 32, 35, 36, and 38 of copending Application No. 10/571,382. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process of preparing a polymer of ethylene and C₄₊ alpha olefin in the presence of substantially the same catalyst. Note especially in claim 24 of the copending application where $T = (IIb)$ and claim 27 where R^{12} , R^{13} , or R^{14} are alkyl, cycloalkyl, aryl, alkylaryl, or arylalkyl.

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While claims of the present invention do not recite a multi-stage process, claims drawn to a process “comprising” particular steps do not exclude any unrecited steps. Therefore, it is deemed that the claims of the instant application are generic to, *i.e.*, fully encompass, the claims of the copending application, and therefore, the claims of the instant application are anticipated by the claims of the copending application.

These are provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

6. Claim 1 is objected to because of the following informalities: On page 3 of the claims claims filed on April 9, 2007, please delete the term “saturated or unsaturated” in lines 5, 10, and 14. The term is superfluous since the identity of the substituent implicates saturation or unsaturation. Moreover, one can not have an “unsaturated” C₁-C₂₀ alkyl group. Appropriate correction is required.

7. Claim 1 is objected to because of the following informalities: On page 3, please insert a comma after “halogen atoms” in line 13, and delete “or” on line 14 . Appropriate corrections are required.

8. Claim 1 is objected to because of the following informalities: On page 4, please remove the term “saturated or unsaturated” in lines 1, 3, 4, 6, and 8. Appropriate corrections are required.

9. Claim 1 is objected to because of the following informalities: On page 4, since R³ and R⁴ are defined identically, the claim may be streamlined to include R³ and R⁴ in the same definition. For instance, the claim may state, “R³ and R⁴ are each independently a hydrogen atom...”

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10. Claim 1 is objected to because of the following informalities: On page 4, it is noted that R⁶ corresponds to R¹ (both located on the 5-position of the heterocyclic ligand) and that it is defined identically. The claim may be streamlined to include R¹ and R⁶ in the same definition.

11. Claim 3 is objected to because of the following informalities: Please remove the term "saturated or unsaturated" in lines 3 and 7. Appropriate corrections are required.

12. Claim 3 is objected to because of the following informalities: The claim may be streamlined to include R¹ and R⁶ in the same definition (see paragraph 9, *supra*).

13. Claim 5 is objected to because of the following informalities: Please remove the term "saturated or unsaturated" in lines 3 and 5. Appropriate corrections are required.

14. Claim 5 is objected to because of the following informalities: The two definitions for R⁷ are redundant. The second definition may be deleted. Appropriate correction is required.

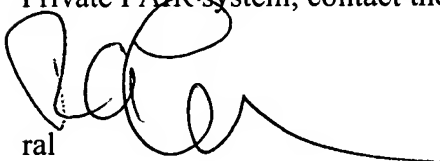
15. Claims remain patentably distinct over the closest patents, Ewen *et al.* (U.S. 6,444,833 and 6,635,779), which disclose the compounds Me₂Si(2,5-Me₂-3-Ph-cyclopentadienyl-thiophene)₂ZrCl₂ and Me₂Si(2,5-Me₂-3-(2'-MePh)cyclopentadienyl-thiophene)₂ZrCl₂, and Me₂Si(2,5-Me₂-3-(2',4',6'-MePh)cyclopentadienyl-thiophene)₂ZrCl₂ having utility as a polymerization catalyst component. The compounds possess the requisite substituent in the 5-position of the cyclopentadienylthiophene ring, but they lack the appropriate substitution pattern in the 3-phenyl substituent. There is no teaching or suggestion to make compounds of formula (IV) in the instant claims and use them in a polymerization process to make the claimed polymer.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu S. Jagannathan, can be reached at (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<http://pair-direct.uspto.gov>>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).



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December 18, 2007